



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/379,167	08/23/1999	BRUCE EISEN	M-7729-US	9947

24251 7590 12/05/2001

SKJERVEN MORRILL MACPHERSON LLP  
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/379,167</b>	Applicant(s) <b>Eisen et al.</b>
Examiner <b>John Young</b>	Art Unit <b>2162</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Aug 23, 1999

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-74 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-74 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 6 & 8 20)  Other: \_\_\_\_\_

Art Unit: 2162

**FIRST ACTION REJECTION****DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

**CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following are quotations of 35 U.S.C. §103 ( a ) which form the basis of the obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Independent claims 1 & 22 and dependent claims 2-21 & 23-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dedrick, US 5,724,521 (3/3/1998) (herein referred to as “Dedrick”) in view of Deaton 6,292,786 (09/18/2001) [US f/d: 08/11/1999] (herein referred

Art Unit: 2162

to as "Deaton") and further in view of Angles 5,933,811 (08/03/1999) (herein referred to as "Angles").

As per claim 1, Dedrick (FIG. 1 through FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; col. 1, ll. 14-21; col. 3, ll. 29-67; col. 15, ll. 15-31; col. 4, ll. 1-67; col. 7, ll. 9-15 and the ABSTRACT) shows elements that suggest the: "method for electronically sending promotional material based upon consumer tastes and preferences. . ." via "electronic mail . . ."

Dedrick lacks an explicit recital of the elements and limitations of sending the electronic mail as claimed in claim 1.

Deaton (FIG. 8B; FIG. 8C; and FIG. 1) shows elements that suggest the elements and limitations of sending the electronic mail as claimed in claim 1.

Deaton proposes e-mail generation modifications that would have applied to the method and system of Dedrick. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Deaton with the method and system of Dedrick because such combination would have provided means wherein "[customers] may be induced to loyalty to a particular store. . ." (see Deaton (col. 19, ll. 1-10)) and because such combination would have provided means for comparing "The characteristics of the individual end users with a consumer scale associated with the electronic advertisement." (See Dedrick (col. 2, ll. 5-7)).

Dedrick lacks an explicit recital of: "sending promotional material to the consumer based upon the tracked consumer movement within the embedded Internet web sites."

Art Unit: 2162

Angles (FIG. 3; FIG. 4; FIG. 5; and FIG. 6) shows elements that suggest: "sending promotional material to the consumer based upon the tracked consumer movement within the embedded Internet web sites."

Angles provides "embedded Internet web sites" modifications that would have applied to the method and system of Dedrick. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the modifications of Angles with the method and system of Dedrick because such modifications would have provided a means of "merging the electronic page . . . and the customized advertisement" in conjunction with e-mail distribution. (See Angles col. 23, ll. 5-35).

As per claim 2, Dedrick in view of Deaton and Angles shows the method of claim 1.

Dedrick does not explicitly show: "acquiring the consumer's email address." "Official Notice" is taken that both the concept and the advantages of "acquiring the consumer's email address . . ." were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because acquisition of an e-mail address would have enabled a merchant to send promotional material to a prospective client.

As per claim 3, Dedrick in view of Deaton and Angles shows the method of claim 2.

Dedrick does not explicitly show the elements of claim 3.

Art Unit: 2162

“Official Notice” is taken that both the concept and the advantages of “wherein the electronic mail address is acquired at the point of sale location. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because acquisition of an e-mail address would have enabled a merchant to send promotional material to a prospective client.

As per claim 4, Dedrick in view of Deaton and Angles shows the method of claim 2.

Dedrick does not explicitly show the elements of claim 4.

“Official Notice” is taken that both the concept and the advantages of “wherein the electronic mail address is acquired electronically. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because acquisition of an e-mail address would have enabled a merchant to send promotional material to a prospective client.

As per claim 5, Dedrick in view of Deaton and Angles shows the method of claim 2.

Dedrick does not explicitly show the elements of claim 5.

“Official Notice” is taken that both the concept and the advantages of “wherein the unique identifier for the electronic mail address is an alphanumeric tag. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the

Art Unit: 2162

invention because acquisition of an e-mail address would have enabled a merchant to send promotional material to a prospective client.

As per claim 6, Dedrick in view of Deaton and Angles shows the method of claim 1.

Dedrick lacks an explicit recitation of the elements of claim 6.

“Official Notice” is taken that both the concept and the advantages of “wherein the plurality of accessed Internet web sites include a plurality of links to other web pages that can be located at a plurality of web servers. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such a network would have enabled a merchant to send promotional material to a plurality of prospective clients.

As per claim 7, Dedrick in view of Deaton and Angles shows the method of claim 6.

Dedrick lacks an explicit recitation of the elements of claim 7.

“Official Notice” is taken that both the concept and the advantages of “wherein the plurality of links to other web pages includes a link to a web page from where the consumer can purchase merchandise. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such links would have enabled a merchant to send promotional material to a plurality of prospective clients.

Art Unit: 2162

As per claim 8, Dedrick in view of Deaton and Angles shows the method of claim 6.

Dedrick lacks an explicit recitation of the elements of claim 8.

“Official Notice” is taken that both the concept and the advantages of “wherein the plurality of links to other web pages includes a link to a web page from where the consumer can electronically view images of merchandise. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such links would have enabled a prospective client to view and select merchandise on-line.

As per claim 9, Dedrick in view of Deaton and Angles shows the method of claim 6.

Dedrick lacks an explicit recitation of the elements of claim 9.

“Official Notice” is taken that both the concept and the advantages of “wherein the plurality of links to other web pages includes a link to a web page from where the consumer may electronically contact a seller. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such links would have enabled a prospective client to obtain further information on or purchase merchandise on-line.

As per claim 10, Dedrick in view of Deaton and Angles shows the method of claim 1.

Art Unit: 2162

Dedrick lacks an explicit recitation of the elements of claim 10.

“Official Notice” is taken that both the concept and the advantages of “wherein the consumer movement within the plurality of accessed embedded Internet web sites is stored in a log file. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to determine customer preferences.

As per claim 11, Dedrick in view of Deaton and Angles shows the method of claim 10.

Dedrick lacks an explicit recitation of the elements of claim 11.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes the addresses of the plurality of web sites accessed by the consumer. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to determine customer preferences.

As per claim 12, Dedrick in view of Deaton and Angles shows the method of claim 10.

Dedrick lacks an explicit recitation of the elements of claim 12.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes information regarding the number of times the consumer accesses a

Art Unit: 2162

particular web site. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to determine customer preferences.

As per claim 13, Dedrick in view of Deaton and Angles shows the method of claim 10.

Dedrick lacks an explicit recitation of the elements of claim 13.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes information regarding any purchase the consumer makes while visiting the accessed web site. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to provide promotional awards or incentive points.

As per claim 14, Dedrick in view of Deaton and Angles shows the method of claim 10.

Dedrick lacks an explicit recitation of the elements of claim 14.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes the duration of the consumer’s visit to a particular web site. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to determine customer preferences.

Art Unit: 2162

As per claim 15, Dedrick in view of Deaton and Angles shows the method of claim 10.

Dedrick lacks an explicit recitation of the elements of claim 15.

“Official Notice” is taken that both the concept and the advantages of “developing a consumer master database based upon the log file; querying the master database; and determining consumer preferences. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such methods would have enabled a merchant to quantify and qualify the number of potential consumers who had a genuine interest in their merchandise.

Claim 16 is rejected for substantially the same reasons as claim 15.

Claim 17 is rejected for substantially the same reasons as claim 15.

Claim 18 is rejected for substantially the same reasons as claim 15.

Claim 19 is rejected for substantially the same reasons as claim 15.

Claim 20 is rejected for substantially the same reasons as claim 15.

Art Unit: 2162

As per claim 21, Dedrick in view of Deaton and Angles shows the method of claim 15.

Dedrick lacks an explicit recitation of the elements of claim 21.

“Official Notice” is taken that both the concept and the advantages of “wherein the master database includes a credit card segment that includes consumer credit card number date and amount of purchase by consumer. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to provide promotional awards or incentive points.

Claim 22 is rejected for substantially the same reasons as claim 1.

Claim 23 is rejected for substantially the same reasons as claim 2.

Claim 24 is rejected for substantially the same reasons as claim 3.

Claim 25 is rejected for substantially the same reasons as claim 4.

Claim 26 is rejected for substantially the same reasons as claim 5.

Claim 27 is rejected for substantially the same reasons as claim 6.

Art Unit: 2162

Claim 28 is rejected for substantially the same reasons as claim 7.

Claim 29 is rejected for substantially the same reasons as claim 8.

Claim 30 is rejected for substantially the same reasons as claim 9.

Claim 31 is rejected for substantially the same reasons as claim 10.

Claim 32 is rejected for substantially the same reasons as claim 11.

Claim 33 is rejected for substantially the same reasons as claim 12.

Claim 34 is rejected for substantially the same reasons as claim 13.

Claim 35 is rejected for substantially the same reasons as claim 14.

Claim 36 is rejected for substantially the same reasons as claim 15.

Claim 37 is rejected for substantially the same reasons as claim 16.

Claim 38 is rejected for substantially the same reasons as claim 17.

Art Unit: 2162

Claim 39 is rejected for substantially the same reasons as claim 18.

Claim 40 is rejected for substantially the same reasons as claim 19.

Claim 41 is rejected for substantially the same reasons as claim 20.

Claim 42 is rejected for substantially the same reasons as claim 21.

3. Independent claims 43 & 59 and dependent claims 44-58 & 60-74 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dedrick.

As per claim 43, Dedrick (FIG. 1 through FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; col. 1, ll. 14-21; col. 3, ll. 29-67; col. 15, ll. 15-31; col. 4, ll. 1-67; col. 7, ll. 9-15 and the ABSTRACT) shows elements that suggest the elements and limitations of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 43.

“Official Notice” is taken that both the concept and the advantages of “acquiring consumer credit card information; tracking consumer movement within a plurality of web sites located at a plurality of web servers, and sending promotional material to the consumer based upon the tracked consumer movement within the web site. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to target specific

Art Unit: 2162

consumer segments for specific promotional incentive, and thereby saving the merchant expenses that would ordinarily be sent en masse to unqualified consumers.

As per claim 44, Dedrick shows the method of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 44.

“Official Notice” is taken that both the concept and the advantages of “wherein the credit card information is acquired when a consumer purchases an item from a seller’s web site. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such an acquisition would have enabled a merchant to identify a consumer and collect payment from said consumer.

As per claim 45, Dedrick shows the method of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 45.

“Official Notice” is taken that both the concept and the advantages of “wherein the credit card information includes [sic] consumer name. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such information would have enabled a merchant to identify a consumer, as well as, collect payment from said consumer.

As per claim 46, Dedrick shows the method of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 46.

Art Unit: 2162

“Official Notice” is taken that both the concept and the advantages of “wherein the credit card information includes [sic] consumer mailing address. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such information would have enabled a merchant to identify a consumer, as well as, send merchandise to a correct address or later contact the consumer.

As per claim 47, Dedrick shows the method of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 47.

“Official Notice” is taken that both the concept and the advantages of “wherein the credit card information includes [sic] consumer email address. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such information would have enabled a merchant to identify a consumer, as well as, later contact the consumer.

As per claim 48, Dedrick shows the method of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 48.

“Official Notice” is taken that both the concept and the advantages of “wherein the movement is tracked by an IP address corresponding to the consumer’s credit card information and stored in a log file. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to provide promotional awards or incentive points.

Art Unit: 2162

As per claim 49, Dedrick shows the method of claim 48.

Dedrick lacks an explicit recitation of the elements of claim 49.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes information regarding the purchase the consumer makes while visiting the accessed web site. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to provide promotional awards or incentive points.

As per claim 50, Dedrick shows the method of claim 48.

Dedrick lacks an explicit recitation of the elements of claim 50.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes the duration of the consumer’s visit to a particular web site. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such tracking would have enabled a merchant to qualify the consumer.

As per claim 51, Dedrick shows the method of claim 48.

Dedrick lacks an explicit recitation of the elements of claim 51.

“Official Notice” is taken that both the concept and the advantages of “developing a master database based upon the log file; querying the master database; and determining consumer preferences. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such methods would have enabled a

Art Unit: 2162

merchant to quantify and qualify the number of potential consumers who had a genuine interest in their merchandise.

Claim 52 is rejected for substantially the same reasons as claim 51.

Claim 53 is rejected for substantially the same reasons as claim 51.

Claim 54 is rejected for substantially the same reasons as claim 51.

Claim 55 is rejected for substantially the same reasons as claim 51.

Claim 56 is rejected for substantially the same reasons as claim 51.

As per claim 57, Dedrick shows the method of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 57.

“Official Notice” is taken that both the concept and the advantages of “promotional material is sent to [sic] consumer electronically. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such methods would have enabled a consumer to receive promotional awards online.

Art Unit: 2162

As per claim 58, Dedrick shows the method of claim 43.

Dedrick lacks an explicit recitation of the elements of claim 58.

“Official Notice” is taken that both the concept and the advantages of “promotional material is sent to [sic] consumer at consumer’s mailing address. . . .” were obvious, well known and expected in the art by one of ordinary skill at the time of the invention because such methods would have enabled a consumer to keep track of promotional awards.

Claim 59 is rejected for substantially the same reasons as claim 43.

Claim 60 is rejected for substantially the same reasons as claim 44.

Claim 61 is rejected for substantially the same reasons as claim 45.

Claim 62 is rejected for substantially the same reasons as claim 46.

Claim 63 is rejected for substantially the same reasons as claim 47.

Claim 64 is rejected for substantially the same reasons as claim 48.

Claim 65 is rejected for substantially the same reasons as claim 49.

Art Unit: 2162

Claim 66 is rejected for substantially the same reasons as claim 50.

Claim 67 is rejected for substantially the same reasons as claim 51.

Claim 68 is rejected for substantially the same reasons as claim 52.

Claim 69 is rejected for substantially the same reasons as claim 53.

Claim 70 is rejected for substantially the same reasons as claim 54.

Claim 71 is rejected for substantially the same reasons as claim 55.

Claim 72 is rejected for substantially the same reasons as claim 56.

Claim 73 is rejected for substantially the same reasons as claim 57.

Claim 74 is rejected for substantially the same reasons as claim 58.

Art Unit: 2162

## CONCLUSION

4. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Sixth floor Receptionist  
Crystal Park II  
2121 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Serial Number: 09/379,167

(Eisen et al..)

21

Art Unit: 2162

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young *PLY*

Patent Examiner



ERIC W. STAMBER  
PRIMARY EXAMINER

November 28, 2001